

REMARKS

In accordance with the foregoing, the specification is amended to correct an informality, and claim 1 and claims 5-7 are amended. New claims 9-16 are added.

ITEMS 2-3: REJECTION OF CLAIMS 1 and 5 AS INDEFINITE UNDER 35 U.S.C. §112, ¶2

Claims 1 and 5 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner contends:

. . . claim 1, recites "a coordinate value input last before input means is detached from the surface of said input unit as the previous coordinate value to a coordinate value input first after the input means is detached from the surface of said input unit". Such recitation is not clear to the examiner. . .

(Action at page 2)

The Action does not provide comments as to the rejection of claim 5.

Traverse of Rejection

Claims 1 and claim 5 are amended herein to clarify that the coordinate detection device, and method of detecting coordinates, respectively includes:

. . . calculating a difference between coordinate values of previous and current input operations . . . the coordinate values being successive over detachment of the input means from the surface of said input unit; and . . . setting. . . a coordinate value at a time when the input means is detached from the surface of said input unit as the coordinate value of the previous input operation.

As shown in FIG. 11 for example, an input means e.g., a pen or a finger is "detached from the surface of the coordinate input panel between one operation and the following operation (See page 23, starting at line 9)."

Claim 1, as amended, and claim 5, as amended, are submitted to be in compliance with 35 U.S.C. §112, second paragraph and withdrawal of the rejection is requested.

ITEM 5: REJECTION OF CLAIMS 1-3 AND 5-7 FOR OBVIOUSNESS UNDER 35 U.S.C. §103 BY HIRAYAMA ET AL. (U.S.P. 5,406,307)

Claims 1-3 and 5-7 are rejected for obviousness over Hirayama et al. The Action concedes that Hirayama "does not expressly teach . . . (setting) . . . the coordinate values before and after the input means (3) is detached." However, the Action contends that it would have been obvious:

. . . to realize that the coordinates of the input means . . . (are). . . always stored in the memory so as to be able to update the location of the pen and that can't be accomplished without storing it in a memory.

(Action at page 4)

Traverse Of The Rejection***Prima Facie* Obviousness Not Established**

As provided in MPEP §2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F. 2d 1981, (CCPA 1974).

Independent claims 1 and 5 (both as amended herein) recite "calculating a difference between coordinate values of previous and current input operations . . . the coordinate values being successive over detachment of the input means from the surface of said input unit; and . . . setting . . . a coordinate value at a time when the input means is detached from the surface of said input unit as the coordinate value of the previous input operation."

These features are not taught, or suggested, in any of the lines cited by the Examiner, or anywhere else within Hirayama et al. The Action contends that Hirayama et al. teaches:

. . . setting a coordinate value input last before the input means is detached from the surface of the input unit as the previous coordinate value to a coordinate value input first after the input means is detached from the surface of the input unit (this is carried out by having the position of the pen (3) before detached is the same after detaches which allows the enlarging of the window) (col. 6, lines 3-21).

(Action at page 3)

In the lines cited by the Examiner, Hirayama et al. discloses that a user "moves the point of the pen 3 . . . and drags the pen 3 to the position shown . . . , then the large display icon . . . is moved to the position (See col. 6, lines 10-15)." That is Hirayama et al. merely compares a "shifted amount of the pen coordinate with a reference shift (See col. 5, lines 45-47)." It does not disclose calculating a difference between coordinate values of previous and current input operations with the coordinate values being successive over detachment of the input means from the surface of an input unit.

The Examiner also contends on page 4, that:

. . . it is known to a person of ordinary skill in the art that the location of the stylus in each movement of the pen 93) [sic] is stored in the memory (col. 4, lines 19-23).

However, Hirayama et al. in col. 4, lines 19-25 cited by the Examiner, does not describe a location of stylus of a pen is stored in memory, but instead discloses:

(A) tablet interface circuit 31 is formed as one body with the display portion 1 for the input tablet 2 and the pen 3. Data written in the input tablet 2 or the like is supplied to the CPU 21 by means of the tablet interface circuit 31.

Even assuming *arguendo* that the Examiner's contentions concerning what is known to a person of ordinary skill are correct, it is submitted that the features and limitations of the claims are not taught.

Prima Facie Obviousness Not Established For Dependent Claims

In rejecting dependent claims 2 and 6, the Examiner contends that as shown in FIG. 4A of Hirayama et al.:

either moving the enlarged icon (step S8) or step S9 whereat the icon is activated (col. 6, lines 3-21) . . . fairly reads on the changing of the operation mode.

(Action at page 4)

However, Applicant submits Hirayama et al. does not teach, the recited feature of claim 2's control unit which enables or disables a setting unit based on a determination result of a determination unit or claim 6 (as amended) enabling or disabling setting based on a determination result of determining.

In rejecting dependent claims 3 and 7, the Examiner contends that Hirayama teaches:

determination of the operation mode of the input unit is based on a contact area formed by a contact of the input means with the surface of the input unit (col. 6, lines 3-21).

(Action at page 4)

It is also submitted that Hirayama et al. does not teach within the lines cited, or anywhere else, determination of the operation mode of the input unit based on a contact area.

ITEM 6: REJECTION OF CLAIMS 4 AND 8 FOR OBVIOUSNESS UNDER 35 U.S.C. §103 BY HIRAYAMA ET AL. IN VIEW OF FURUHATA ET AL. (U.S.P. 5,943,043)

Dependent claims 4 and 8 are rejected for obviousness over Hirayama et al. in view of Furuhashi et al. The Action concedes that Hirayama et al. does not teach:

determining the operation mode of the input unit based on a time during which the input means is detached from the surface of the input unit.

(Action at page 5)

However, the Action contends that it would have been obvious:

. . . to make the changing mode of the device based on the time, to be included in the Hirayama's device so as to provide an accurate output based on the user's determination.

(Action at page 4)

No Motivation Stated Within the Cited Art To Combine In The Manner Proposed By the Examiner

The courts have repeatedly reaffirmed the "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Sang-Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

There is no showing of an incentive or motivation to modify Hirayama et al.'s data processing apparatus "in which information is input by using a pen (See col. 1, lines 9-10)," with teachings of Furuhashi et al. directed toward "touch input systems using

fingers (that) do not require special devices, such as a pen (See col. 2, lines 48-50)" in a manner suggested by the Examiner or for any other reason.

Summary

Since *prima facie* obviousness has not been established and there is no incentive to combine the prior art, the rejections should be withdrawn and claims 1-12 allowed

NEW CLAIMS 9-16

New claims 9-16 present no new matter and are provided to afford a varying scope of protection. New claims 9-12 recite a coordinate detection device as illustrated, for example, in FIG. 3 of the application (See pages 8-10, starting at line 32). New claims 13-16 recite a method of coordinate detection as illustrated, for example, in FIGS. 6-8 (See pages 14-21, starting at line 31).

Claims 9-12 patentably distinguish over the cited references and are submitted to be allowable for the recitations therein.

CONCLUSION

No new matter is presented in any of the foregoing and, accordingly, approval and entry of the amended specification, amended claims, and new claims are respectfully requested. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is respectfully requested.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: September 5, 2003

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